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10/003,069	12/06/2001	Masashi Shiomi	0033-0778P	4862

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BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER
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PAULA, CESAR B

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/003,069	Applicant(s) SHIOMI ET AL.	
	Examiner CESAR B PAULA	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                      | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                             | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>7/29/04</u> | 6) <input type="checkbox"/> Other: _____                                    |

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### **DETAILED ACTION**

1. This action is responsive to the application, and IDSs filed on 12/6/2004, and 6/5/2003, 6/1, and 7/29/2004 respectively.

**This action is made Non-Final.**

2. Claims 1-33 are pending in the case. Claims 1, 8, 12, 17, and 24-26 are independent claims.

### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 9/22/2000 has been entered, and considered by the examiner.

### ***Priority***

4. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d), and based on application # 2000-371676 filed in Japan on 12/6/2000, which papers have been placed of record in the file.

### ***Drawings***

5. The drawings filed on 12/6/2001 have been approved by the examiner.

***Claim Objections***

6. Claims 1-7 are objected to because of the following informalities: “the desired information externally supplied from outside” claim 1, lines 3-4. The underlined words make this limitation redundant, because external means outside. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 22-23, and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claims 22-23 recite the limitation "said advertiser" in claim 22, lines 6-7. There is insufficient antecedent basis for this limitation in the claim. There are many “advertisers”, not just a single “advertiser” in this claim or claim(s) it depends on.

10. Claim 31 recites the limitation "said additional data to be added next" in line 4. There is insufficient antecedent basis for this limitation in the claim. There is no previous are many “additional data to be added next” in this claims or claim(s) it depends on.

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***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-19, 21, and 24-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Judson (Pat.# 5,572,643, 11/5/1996).

Regarding independent claim 1, Judson discloses a client retrieving a web page having an embedded or masked object, such as an advertisement, stored within *–receiving desired information together with advertisement --* (col.2, lines 1-11, 35-45, 54-67, col.4, lines 1-35, and col.5, lines 40-67).

Moreover, Judson discloses retrieving, and displaying the embedded or masked object, such as an advertisement, as a result of activating a link on the web page *–executing a prescribed process on said desired information, presenting when said prescribed process is executed by said processing means an advertisement based on said advertisement data received by said information receiving unit--* (col.2, lines 1-11, 35-45, 54-col. 3, line 2, and col.5, lines 40-col.6, line 11).

Regarding claim 2, which depends on claim 1, Judson discloses downloading a web page storing an embedded or masked object, such as an advertisement, stored within the client's

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RAM, or cache memory *—receiving desired information together with advertisement --* (col.2, lines 1-11, 35-45, 54-67, and col.4, lines 1-35).

Moreover, Judson discloses displaying the embedded or masked object, such as an advertisement, as a result of activating a link on the web page *—reading said desired information receiving unit--* (col.2, lines 1-11, 35-45, 54-col. 3, line 2, and col.5, lines 40-col.6, line 11).

Regarding claim 3, which depends on claim 1, Judson discloses a browser downloading a web page storing an embedded or masked object within HTML tags *—additional data corresponding to a HTML type to be added as an object* after the user selects the link --, such as an advertisement, stored within the client having a hard disk (col.2, lines 1-11, 35-45, 54-67, and col.4, lines 1-35).

Regarding claim 4, which depends on claim 1, Judson discloses the client using a browser for downloading the web page storing the advertisement, using a modem for communicating with other computers over a network *—communication unit for communicating with the outside through a communication path, and receiving through said communication unit, desired information together with advertisement --* (col.2, lines 1-11, 35-45, 54-67, and col.4, lines 1-4, 30-35).

Regarding claim 5, which depends on claim 4, Judson discloses a browser for downloading a web page from a server by selecting a link *—specifying HTML type of said additional data, based on execution result of said prescribed process by said processing means,*

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*and receiving from the outside...said additional data* -- (col.1, lines 27-33, col.2, lines 1-11, 35-45, 54-67, col.4, lines 30-35). The downloading is performed using a modem for communicating with other computers over a network for retrieving the web page.

Regarding claim 6, which depends on claim 5, Judson discloses a browser for selecting advertisements based on the user's web page access history—*advertisement specifying data for specifying said advertisement data* (col.7, lines 10-17). In this case, the browser receives the access history—*advertisement data included in said acquisition request transmitted by said additional data requesting means*.

Regarding claim 7, which depends on claim 1, Judson discloses clients for downloading a web page, which stores the advertisement. The clients are personal computers (col.1, lines 27-33, col.2, lines 1-11, 35-45, 54-67, col.3, lines 47-67). Personal computer can be carried from one location to the next—*portable apparatus*.

Regarding independent claim 8, Judson discloses a client using a modem for downloading or receiving a web page having, a link, and a embedded or masked object, such as an advertisement, over a network —*receiving desired information for executing a prescribed process, and advertisement data related to the desired information* -- (col.1, lines 27-33, col.2, lines 1-11, 35-45, 54-67, col.4, lines 1-35, and col.5, lines 40-67).

Moreover, Judson discloses storing of the retrieved web page along with the embedded objects, in memory, such as RAM, cache or hard drive, installed in the client's computer —

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*executing a prescribed process on said desired information, presenting when said prescribed process is executed by said processing means an advertisement based on said advertisement data received by said information receiving unit--* (col.2, lines 1-11, 35-45, 54-67, col. 4, lines 1-35, and col.5, lines 40-col.6, line 11, fig.2).

Regarding claim 9, which depends on claim 8, Judson discloses a client using a modem for downloading or receiving a web page having an embedded or masked object, such as an advertisement, over a network into RAM, cache or hard drive --*stores in advance information specifying data for specifying said desired information and advertisement specifying data --* (col.1, lines 27-33, col.2, lines 1-11, 35-45, 54-67, col.4, lines 1-35, and col.5, lines 40-67).

Moreover, Judson discloses the downloading of a web page, and retrieval and display of a related advertisement embedded object as a result of selecting and activating the link --*executing a prescribed process on said desired information, presenting when said prescribed process is executed by said processing means an advertisement based on said advertisement data received by said information receiving unit--* (col.2, lines 1-11, 35-45, 54-67, col. 4, lines 1-35, and col.5, lines 40-col.6, line 11, fig.2).

Regarding claim 10, which depends on claim 8, Judson discloses a link stored in the web page to enable a client to download of a web page, retrieve and display of a related advertisement embedded object as a result of selecting and activating the link --*stores in advance connection destination data and said communication unit communicates with said external information*

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*supplying unit based on said connection--* (col.2, lines 1-11, 35-45, 54-67, col. 4, lines 1-35, and col.5, lines 40-col.6, line 11, fig.2).

Regarding claim 11, which depends on claim 8, Judson discloses a client for downloading of a web page, retrieve and display of a related advertisement embedded object as a result of selecting and activating the link (col.2, lines 1-11, 35-45, 54-67, col. 4, lines 1-35, and col.5, lines 40-col.6, line 11, fig.2). In other words, the web page is displayed in addition to the advertisement at the client.

Claims 12-16 are directed towards an information processing terminal for implementing the apparatus found in claims 1-3, 5, and 7 respectively, and therefore are similarly rejected.

Regarding independent claim 17, Judson discloses a browser—*acquisition request receiving means--* for downloading a web page from a server—*data supplying means--* by selecting a link (col.1, lines 27-33, col.2, lines 1-11, 35-45, 54-67, col.4, lines 30-35). The downloading is performed using a modem for communicating with server over a network for retrieving the web page, and the server provides or supplies the web page and the advertisement to the requesting browser.

Regarding claim 18, which depends on claim 17, Judson discloses that the requested web page contains information such as a link, and embedded advertisement objects to be displayed or added as a result of activation of the link (col.2, lines 1-11, 35-45, 54-67, col.4, lines 30-35).

Regarding claim 19, which depends on claim 18, Judson discloses that the browser selects advertisement objects based on previous history of access—*type data representing said additional data--* (col.2, lines 1-11, 35-45, 54-67, col.7, lines 1-17).

Moreover, Judson discloses that the browser stores advertisement objects on a location, such as the browser's home page—*data supply means transmit--*, which are then transmitted to the browser based on the previous history of access requested web page contains information such as a link, and embedded advertisement objects to be displayed or added as a result of activation of the link (col.7, lines 1-17).

Regarding claim 21, which depends on claim 1, Judson discloses the downloading of a web page, containing advertisements embedded in the page, to a client using a link—*acquisition request includes advertisement data --* (col.1, lines 26-33, col.2, lines 1-11, 35-45, 54-67, col.7, lines 1-17).

Moreover, Judson discloses that the downloaded web page is retrieved from the server—*said data supplying means transmits, in response to reception of said acquisition request*, which has the web page and the advertisements (col.1, lines 26-33, col.2, lines 1-11, 35-45, 54-67, col.8, lines 1-21).

Regarding independent claim 24, Judson discloses one of many clients using a modem for downloading or receiving from a server, a web page having an embedded or masked object, such as an advertisement, over a network, as a result of a link activation —*acquisition request for*

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*said desired information from said arbitrary terminal to said acquisition supplying apparatus --* (col.1, lines 27-33, col.2, lines 1-11, 30-45, 54-67, col.3, line 44-col.4, line 35, and col.5, lines 40-67).

Moreover, Judson discloses that in response to the activation of the link, the server sends back a web page, which is displayed, and contains an embedded related advertisement object—*transmitting and supplying said desired information together with advertisement data related to said desired information from said information supplying apparatus --* (col.2, lines 1-11, 35-45, 54-67, col. 4, lines 1-35, and col.5, lines 40-col.6, line 11, fig.2).

Claims 25 is directed towards an information supplying system for implementing the system found in claim 24, and therefore is similarly rejected.

### ***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claims 20, 22-23, and 26-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Judson.

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Regarding claim 20, which depends on claim 19, Judson discloses that the browser downloads advertisement from a server (col.2, lines 1-11, 35-45, 54-67, col.7, lines 1-17). Judson fails to explicitly disclose: *additional data is registered and updated by a data supplier supplying the additional data*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have registered and updated the advertisements by an advertisement supplier, because Judson teaches above displaying advertisements based on the type of access history of a user. This would provide the benefit of providing a variety of updated advertisement which more effectively resembles the tastes of a wide range of clients, in accordance with the latest products available from the advertiser.

Regarding claim 22, which depends on claim 21, Judson discloses that the browser selects advertisement objects based on previous history of access—*acquisition request includes advertisement data* -- (col.2, lines 1-11, 35-45, 54-67, col.7, lines 1-17). Judson fails to explicitly disclose: *advertisement data corresponding to a plurality of advertisers....* However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have stored objects associated with several advertisers, because Judson teaches above displaying advertisements based on the type of access history of a user. This would provide the benefit of providing a variety of advertisement which more effectively resembles the tastes of a wide range of clients.

Regarding claim 23, which depends on claim 22, Judson discloses that the browser downloads advertisement from a server (col.2, lines 1-11, 35-45, 54-67, col.7, lines 1-17).

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Judson fails to explicitly disclose: *advertisement data is registered and updated by corresponding said advertiser*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have registered and updated the advertisements by an advertiser, because Judson teaches above displaying advertisements based on the type of access history of a user. This would provide the benefit of providing a variety of updated advertisement which more effectively resembles the tastes of a wide range of clients, in accordance with the latest products.

Regarding independent claim 26, Judson discloses a browser running, and displaying a web page in each client, which has RAM memory-- *additional data storing unit storing additional data* --(col.2, lines 1-11, col.4, lines 10-24, fig.2).

Moreover, Judson storing embedded objects downloaded together with the web page, in a cache memory—*advertisement storing unit*-- installed in the client's computer. The advertisement is displayed as a result of activating a link in the web page --*advertisement to be presented when said desired information processing is executed* -- (col.2, lines 1-11, 35-45, 54-67, col. 4, lines 1-35, and col.5, lines 40-col.6, line 11, fig.2). Judson fails to explicitly disclose: *a program information storing unit*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have stored the browser in non-volatile memory such as a hard driver, because Judson teaches above hard drive for storing data. This would provide the benefit of providing a permanent storage mechanism for avoiding the time consuming and tedious task of having to reinstall the browser every time the browser is invoked.

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Regarding claim 27, which depends on claim 26, Judson discloses a web page for storing embedded advertisements in HTML format stored in memory, such as RAM, —*storing unit storing advertisement specifying data*. The advertisements are downloaded from a server—*said advertisement specifying data is externally supplied*-- and stored in the client's memory (col. 1, lines 27-33, col.2, lines 1-11, and 30-67, col.4, lines 10-24, and fig.2).

Regarding claim 28, which depends on claim 27, Judson discloses downloading the web page with advertisements, from the server—*supplier of said advertisement data*--by activating a link—*establishing connection*-- stored in a web page, which is stored in memory, such as RAM memory (col.2, lines 1-11, and 30-67, col.4, lines 10-24, and fig.2).

Regarding claim 29, which depends on claim 27, Judson discloses downloading the web page with advertisements—*said advertisement data specifying an advertiser*--, from the server (col.2, lines 1-11, and 30-67, col.4, lines 10-24, and fig.2).

Regarding claim 30, which depends on claim 26, Judson discloses a web page having a link to another web page—*identification information storing unit for storing identification information*-- . The other web page is downloaded, to a client with RAM memory, from a server by activating the link (col.1, lines 26-33, col.4, lines 10-24, 52-67 and fig.2).

Regarding claim 31, which depends on claim 26, Judson discloses that the other web page is downloaded, and stored to memory, to a client from a server by activating the link—*next*

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*order identification information is externally supplied.* As a result of the link activation, coupons are queued and printed—*said additional data to be added next* (col.1, lines 26-33, col.4, lines 10-24, 52-67, col.7, lines 10-36, and fig.2).

Regarding claim 32, which depends on claim 26, Judson discloses a web page determining access history—*execution result unit at the end of link selection--* of a user so as to provide information the user is interested on (col.7, lines 10-16). In other words, a history is compiled after the user has selected a link—*desired information processing is executed--*

Regarding claim 33, which depends on claim 26, Judson discloses a web page determining access history—*identification information stored as execution result unit at the end of said desired information processing of link selection--* of a user so as to provide information the user is interested on (col.7, lines 10-16). In other words, a history is compiled after the user has selected a link—*desired information processing is executed--*

### ***Conclusion***

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bruck et al. (Pat. # 6,268,856), Davis et al. (Pat. # 2003/0065770, and 6,643,696), Goldberg et al. (Pat. # 2003/0060247), Lynn (Pat. # 2003/0003975), and Jacobs et al. (Pat. # 2001/0034763).

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is **(703) 306-5543** (

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**(571) 272-2148 as of 10/12/04**. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (703) 308-5465 ( (571) 272-4124 as of 10/12/04). However, in such a case, please allow at least one business day.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

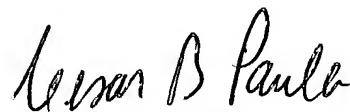
Any response to this Action should be mailed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Or faxed to:

- **(703) 703-872-9306**, (for **all** Formal communications intended for entry)

**Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).**



CESAR B PAULA  
Patent Examiner  
Art Unit 2178

9/30/04